



Practitioner's Docket No. 2605/103 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent application of \_\_\_\_\_  
Inventor(s) \_\_\_\_\_

RECEIVED

for \_\_\_\_\_  
Title of invention \_\_\_\_\_ APR 01 2003

the specification of which is being transmitted herewith

OR

TECH CENTER 1600/2900

In re application of: Miyata, Toshio

Application No.: 10/069,439

Group No.: 1641

Filed: June 7, 2002

Examiner: Not Yet Assigned

For: MEG-1 PROTEIN

Commissioner for Patents  
Washington, D.C. 20231

#9  
H.g.  
4/14/03

SECOND SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) and 1.10\*  
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(Information Disclosure Statement--page 1 of 11)

**NOTE:** "An information disclosure statement shall be considered by the Office if filed by the applicant:

- (1) Within three months of the filing date of a national application;
- (2) Within three months of the date of entry of the national stage as set forth in section 1.491 in an international application; or
- (3) Before the mailing date of a first Office action on the merits, whichever event occurs last." 37 C.F.R. section 1.97(b).

**NOTE:** "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." 37 C.F.R. section 1.56(a).

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) each inventor named in the application;
- (2) each attorney or agent who prepares or prosecutes the application; and
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. section 1.56(c).

**NOTE:** The "duty as described in section 1.56 will be met so long as the information in question was cited by the Office or submitted to the Office in the manner prescribed by sections 1.97(b) - (d) and 1.98 before issuance of the patent." Notice of January 9, 1992, 1135 O.G. 13-25 at 17.

**WARNING:** "No information disclosure statement may be filed in a provisional application." 37 C.F.R. section 1.51(b).

### **List of Sections Forming Part of This Information Disclosure Statement**

The following sections are being submitted for this Information Disclosure Statement:

(check sections forming a part of this statement: disC.F.R.d unused sections and number pages consecutively)

1. ☒ Preliminary Statements
2. ☒ Forms PTO/SB/08A and 08B (substitute for Form PTO-1449)
3. ☐ Statement as to Information Not Found in Patents or Publications
4. ☐ Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted
5. ☐ Cumulative Patents or Publications
6. ☒ Copies of Listed Information Items Accompanying This Statement
7. ☐ Concise Explanation of Non-English Language Listed Information Items
  - 7A. ☐ EPO Search Report
  - 7B. ☐ English Language Version of EPO Search Report
8. ☐ Translation(s) of Non-English Language Documents
9. ☐ Concise Explanation of English Language Listed Information Items (Optional)
10. ☒ Identification of Person(s) Making This Information Disclosure Statement

(complete the following, if appropriate)

Sections \_\_\_\_\_, respectively, have been continued on ADDED PAGE(S).

**NOTE :** "Once the minimum requirements are met, the examiner has an obligation to consider the information." Notice of April 20, 1992 (1138 O.G. 37-41, 37).

## **Section 1. Preliminary statements**

Applicants submit herewith patents, publications or other information, of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. section 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.

## Section 2. Forms PTO/SB/08A and 08B (substitute for Form PTO-1449)

**NOTE:** With respect to the list required by paragraph (b) of 37 C.F.R. section 1.98, the Notice of April 20, 1992 (1138 O.G. 37-41) points out that:

*"The list may not be incorporated into the specification but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement, and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A copy of a separate list will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered. Use of form PTO-1449, "Information Disclosure Citation, is encouraged."*

**NOTE:** *"An information disclosure statement may include two list[s] (and two certifications[])... in situations where some of the information listed was cited in a communication from a foreign patent office not more than three months prior to filing the statement and some was not, but was not known more than three months prior to filing the statement." Notice of April 20, 1992 (1138 O.G. 37-41, 40).*

**NOTE:** With respect to the examiner's consideration of the Information Disclosure Statement, the Notice of April 20, 1992 (1138 O.G. 37-41) states:

*"If information is listed in the specification rather than in a separate paper, or if the other content requirements \*\*\* are not complied with, the examiner will notify applicant in the next Office action that the information has not been considered. It should be noted, however, that no copy of a U.S. patent application is required to be submitted. \*\*\* Where a U.S. patent application is properly cited, the examiner should obtain access to that file within the Office.*

*"Examiners must consider all citations submitted in conformance with the rules and this section and place their initials adjacent [sic] the citations on a list or in the boxes provided on a form PTO-1449. If the citations are submitted on a list other than a form PTO-1449, the examiner may write "all considered" and his or her initials to indicate that all citations have been considered. If any of the citations are considered, a copy of the submitted list or form, as reviewed by the examiner, will be returned to the applicant with the next communication. The original copy of the form will be entered into the application file. The copy returned to applicant will serve both as acknowledgement of receipt of the information disclosure statement and as an indication that the references were considered by the examiner. Forms PTO-326 and PTOL-37 include a box to indicate the attachment of form PTO-1449.*

*"Information which complies with requirements as discussed in this section but which is in a non-English language will be considered in view of the concise explanation submitted \*\*\* and insofar as it is understood on its face, e.g., drawings, chemical formulas, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches. The examiner need not have the information translated unless it appears to be necessary to do so. \*\*\* The examiner should not require that a translation be filed by applicant. The examiner should not make any comment such as that the non-English language information has only been considered to the extent understood, since this fact is inherent*

*"Since information is required to be listed in a separate paper rather than in the specification, there is no need to mark "All checked" or "Checked" in the margin of a specification containing citations.*

*"If a statement fails to comply with the requirements as discussed in this section for an item of information, a line should be drawn through the citation to show that it has not been considered. The other items of information listed that do comply with the rules and this section will be considered by the examiner and will be appropriately initialed.*

\* \* \* \* \*

*"A citation listed on form PTO-1449 and considered by the examiner in accordance with this section will be printed on the patent. A citation listed in a separate paper, equivalent to but not on form PTO-1449, and considered by the examiner in accordance with this section will be printed on the patent if the list is on a separate sheet which is clearly identified as an information disclosure statement and the list lends itself to easy capture of the necessary information by the Office printing contractor, i.e., each item of information is listed on a single line, the lines are at least double-spaced from each other, the information is uniform in format for each listed item, the list includes a column for the examiner's initials to indicate that the information was considered. If a citation is not printed on the patent but has been considered by the examiner in accordance with this section, the patented file will reflect that fact..."*

**SECTION 2. FORMS PTO/SB/08A and 08B (formerly Form PTO-1449)**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Miyata, Toshio      Attorney Docket: 2605/103  
Serial No: 10/069,439      Art Group Unit: 1641  
Date Filed: June 7, 2002      Examiner Name: Not Yet Assigned  
Invention: **MEG-1 PROTEIN**



**LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S  
SECOND SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

**United States Patents**

Examiner Initials	Reference Number	Document Number	Issue Date	Inventor	Class/Subclass
_____	AI	4,873,191	Oct. 10, 1989	Wagner, et al.	435/172.3

**International Patents**

Examiner Initials	Reference Number	Document Number	Issue Date	Inventor	Class/Subclass
_____	AJ	EP 0 386 240 B1	19 July 1995	Kawauchi, et al.	C12N 9/64

**Other Documents**

Examiner Initials	Reference Number	Author	Title of Article, Title of Journal, Volume Number, Page Numbers, Date
_____	AK	Berger, et al.	Inhibition of Intractable Nucleases with Ribonuclease - Vanadyl Complexes: Isolation of Messenger Ribonucleic Acid from Resting Lymphocytes, <i>Biochemistry</i> , Vol. 18, No. 23, pp. 5143-5149, 1979
_____	AL	Chirgwin, et al.	Isolation of Biologically Active Ribonucleic Acid from Sources Enriched in Ribonuclease, <i>Biochemistry</i> , Vol. 18, No. 24, pp. 5294-5299, 1979

_____	AM	Salant, et al.	Experimental Membranous Glomerulonephritis in Rats, <i>J. Clin. Invest.</i> , Vol. 66, pp. 71-81, July 1980
_____	AN	Grantham, et al.	Codon catalog usage is a genome strategy modulated for gene expressivity, <i>Nucleic Acids Research</i> , Vol. 9, No. 1, pp. r43-r74, 1981
_____	AO	Mulligan, et al.	Selection for animal cells that express the <i>Escherichia coli</i> gene coding for xanthine-guanine phosphoribosyltransferase, <i>Proc. Natl. Acad. Sci. USA</i> , Vol. 78, No. 4, pp. 2072-2076, April 1981
_____	AP	Norrande, et al.	Construction of improved M13 vectors using oligodeoxynucleotide-directed mutagenesis, <i>Gene</i> , 26, pp. 101-106, 1983
_____	AQ	Hunkapiller, et al.	A microchemical facility for the analysis and synthesis of genes and proteins, <i>Nature</i> , Vol. 310, pp. 105-111, 12 July 1984
_____	AR	Mark, et al.	Site-specific mutagenesis of the human fibroblast interferon gene, <i>Proc. Natl. Acad. Sci. USA</i> , pp.5662-5666, September 1984
_____	AS	Studier, et al.	Use of Bacteriophage T7 RNA Polymerase to Direct Selective High-level Expression of Cloned Genes, <i>J. Mol. Biol.</i> , 189, pp. 113-130, 1986
_____	AT	Miyata, et al.	Rat mesangial cells actively produce phosphatidylinositol-anchored Thy-1, <i>Immunology</i> , 67, pp. 531-533, 1989
_____	AU	Lavitrano, et al.	Sperm Cells as Vectors for Introducing Foreign DNA into Eggs: Genetic Transformation of Mice; <i>Cell</i> ; Vol. 57; pp. 717-723; June 2, 1989

_____	AV	Miyata, et al.	Determination of the molecular nature and cellular localization of Thy-1 in human renal tissue, <i>Immunology</i> , 69, pp. 391-395, 1990
_____	AW	Mizushima, et al.	pEF-BOS, a powerful mammalian expression vector, <i>Nucleic Acids Research</i> , Vol. 18, No. 17, p. 5322, 1990
_____	AX	Okubo, et al.	Large scale cDNA sequencing for analysis of quantitative and qualitative aspects of gene expression, <i>Nature Genetics</i> , Vol. 2, pp. 173-179, November 1992
_____	AY	Matsubara, et al.	cDNA analyses in the human genome project, <i>Gene</i> , 135, pp. 265-274, 1993
_____	AZ	Inouye, et al.	Isolation of a cDNA Encoding a Metal response Element Binding Protein Using a Novel Expression Cloning Procedure: The One Hybrid System, <i>DNA and Cell Biology</i> , Vol. 13, No. 7, pp. 731-742, 1994
_____	BA	Iida, et al.	Characterization of Genomic <i>PIG-A</i> Gene: A Gene for Glycosylphosphatidylinositol-Anchored Biosynthesis and Paroxysmal Nocturnal Hemoglobinuria, <i>Blood</i> , Vol. 83, No. 11, pp. 3126-3131, (June 1) 1994
_____	BB	Sampaio, et al.	Organization, Regulatory Sequences, and Alternatively Spliced Transcripts of the Mucosal Addressin Cell Adhesion Molecule-1 (MAdCAM-1) Gene, <i>The Journal of Immunology</i> , 155, pp. 2477-2486, 1995
_____	BC	Yagi, et al.	Transient expression of type I collagen in glomeruli with anti-Thy-1 antibody-induced mesangial proliferative lesions, <i>Pathology International</i> , 45, pp. 409-414, 1995



_____	BD	Takeuchi, et al.	Induction of the gene encoding mucosal vascular addressin cell adhesion molecule 1 by tumor necrosis factor $\alpha$ is mediated by NF- $\kappa$ B proteins, <i>Proc. Natl. Acad. Sci. USA</i> , Vol. 92, pp. 3561-3565, April 1995
_____	BE	Suzuki, et al.	<i>In situ</i> hybridization studies of matrix metalloproteinase-3, tissue inhibitor of metalloproteinase-1 and type IV collagen in diabetic nephropathy, <i>Kidney International</i> , Vol. 52, pp. 111-119, 1997
_____	BF	Yasuda, et al.	Functional quantitative analysis of the genome in cultured human mesangial cells, <i>Kidney International</i> , Vol. 53, pp. 154-158, 1998
_____	BG	Miyata, et al.	A Mesangium-predominant Gene, Megsin, Is a New Serpin Upregulated in IgA Nephropathy, <i>J. Clin. Invest.</i> , Vol. 120, No. 4, pp. 828-836, June 1998
_____	BH	Kloeker, et al.	Purification and Identification of a Novel Subunit of Protein Serine/Threonine Phosphatase 4, <i>The Journal of Biological Chemistry</i> , Vol. 274, No. 9, pp. 5339-5347, 1999

Examiner Signature:

\_\_\_\_\_

Date Considered:

\_\_\_\_\_

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation *if not* in conformance and not considered. Include copy of this form with next communication to applicant.

## Section 6. Copies of Listed Information Items Accompanying This Statement

*NOTE: 37 C.F.R. section 1.98(a)(2) requires that any information disclosure statement filed under section 1.97 shall include: "A legible copy of: (1) Each U.S. and foreign patent; (ii) Each publication or that portion which caused it to be listed; and (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included . . ."*

*NOTE: The wording in section 1.98(a)(2)(iii) makes it clear that the requirement to submit a copy of each item of information listed in an information disclosure statement does not apply to the citation of a U.S. patent application. Notice of January 9, 1992, 1135 O.G. 13-25, at 14.*

Legible copies of all items listed in Forms PTO/SB/08A and 08B (substitute for Form PTO-1449) accompany this information statement.

*(complete the following, if applicable)*

- ☐ Exception(s) to above:
- ☐ Items in prior application, from which an earlier filing date is claimed for this application, as identified in Section 4.
- ☐ Cumulative patents or publications identified in Section 5.

**Section 10. Identification of Person(s) Making This Information Disclosure Statement**

The person making this certification is

*(check each applicable item)*

- (a) ☐ the inventor(s) who signs below

\_\_\_\_\_  
SIGNATURE OF INVENTOR

\_\_\_\_\_  
*(type name of inventor who is signing)*

- (b) ☐ an individual associated with the filing and prosecution of this application (37 C.F.R. section 1.56(c))

\_\_\_\_\_  
SIGNATURE OF INVENTOR

\_\_\_\_\_  
*(type name of inventor who is signing)*

- (c) ☒ the practitioner who signs below on the basis of the information:

*(check each applicable item)*

☐ supplied by the inventor(s).

☐ supplied by an individual associated with the filing and prosecution of this application. (37 C.F.R. section 1.56(c)).

☒ in the practitioner's file.

  
\_\_\_\_\_  
SIGNATURE OF PRACTITIONER

\_\_\_\_\_  
Morton Chirmomas

\_\_\_\_\_  
*(type or print name of practitioner)*

\_\_\_\_\_  
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